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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/690,367	10/16/2000	Billy P. Taylor	28150.9	3086

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EXAMINER

LUDWIG, MATTHEW J

ART UNIT	PAPER NUMBER
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2178

DATE MAILED: 01/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Applicati n No. 09/690,367	Applicant(s) TAYLOR, BILLY P.	
	Examin r Matthew J. Ludwig	Art Unit 2178	

-- Th MAILING DATE of this communication appears on the cov r sh et with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 August 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-12,20-24 and 32-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-12,20-24 and 32-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications. Restriction requirement filed 8/2/04.
2. Claims 8-12, 20-24, and 32-48, are pending in the case. Claims 11, 23, and 35, are independent claims. Applicant has cancelled claims 1-7, 13-19, and 25-31, in response to the Restriction election.

Election/Restrictions

3. Applicant's election of claims 8-12, 20-24, and 32-48, in the reply filed on 8/2/04 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. **Claim 41 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

In reference to dependent claim 41, the claim recites the phrase "wherein the second location is the document". There is insufficient antecedent basis for this limitation in the claim. The Examiner is unclear as to what specific document is pointing to itself or to another document. Proper correction required.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

7. **Claims 8-12, 20-24, and 32-48, are rejected under 35 U.S.C. 102(e) as being anticipated by Huffman et al., USPN 5,893,132 filed (12/14/1995).**

In reference to independent claim 11, Huffman teaches:

The book-shaped housing includes a receiving slot which physically receives a removable machine-readable storage medium that contains machine-readable data representative of text from a book. The term “book” should be construed broadly as any written or printed composition, i.e. magazines, newspapers, or the like (compare to “*storing a first version of a mass-produced printed paper*”). (See column 5, lines 37-48).

The processor directly converts the text from the book into speech signals for the voice synthesizer (compare to “*translating the first version into a second version of the paper, the second version being displayable on a display device as a likeness of the paper*”). See column 8, lines 1-10.

The first hot spot portion can be synonymously referred to as an “advance page portion” or an “advance page hot spot” for receiving an advance page event (compare to “*detecting a reference at a first location within the paper, the detected reference being associated with a*”).

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second location”). See column 8, lines 50-67. The hot spot provides the reference to the second location, which could be the next page of the newspaper.

The hot spot provides a proficient means of allowing for the movement throughout the newspaper and the linking to various sections of the book (compare to “*forming a link within the second version between the first location and the second location, and the first location being displayable in the display...*”). See column 9, lines 1-42.

In reference to dependent claim 8, Huffman teaches:

A dog-ear dialog box used in embodiments of the electronic book. The dog-ear dialog box displays a list of all dog-eared pages. A user can immediately go to one of the dog-eared pages on the list by touching a display of a selected page number. See column 13, lines 55-67.

In reference to dependent claim 9, Huffman teaches:

Optionally, the machine-readable data is also representative of graphical information within the book. It is noted that the term book should be inclusive of books, magazines, newspapers, or the like. See column 5, lines 35-55.

In reference to depending claim 10, Huffman teaches:

Upon selecting the RF link option, an RF link routine is executed. The RF link routine allows the user to download updates of the text to the electronic book, and/or to interface the electronic book to a personal computer or communication unit. See column 12, lines 52-67.

In reference to dependent claim 12, Huffman teaches:

A dog-ear dialog box used in embodiments of the electronic book. The dog-ear dialog box displays a list of all dog-eared pages. A user can immediately go to one of the dog-eared pages on the list by touching a display of a selected page number. See column 13, lines 55-67.

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The reference teaches a similar dog-ear dialog box, which provides a table of links utilized by the user for navigation throughout the newspaper.

In reference to claims 20, 21 and 22-24, the claims reflect the system comprising instructions used for performing the methods as claimed in numbers 8, and 10-12, respectively, and in further view of the following, are rejected under similar rationale.

In reference to claims 32, 33 and 34-36, the claims reflect the system comprising computer readable instructions used for performing the methods as claimed in numbers 8, and 10-12, respectively, and in further view of the following, are rejected under similar rationale.

In reference to dependent claim 37 and 38, Huffman teaches:

Upon selecting the RF link option, an RF link routine is executed. The RF link routine allows the user to download updates of the text to the electronic book, and/or to interface the electronic book to a personal computer or communication unit. See column 12, lines 52-67.

In reference to dependent claim 39, Huffman teaches:

A dog-ear dialog box used in embodiments of the electronic book. The dog-ear dialog box displays a list of all dog-eared pages. A user can immediately go to one of the dog-eared pages on the list by touching a display of a selected page number. See column 13, lines 55-67. The reference teaches a similar dog-ear dialog box, which provides a table of links utilized by the user for navigation throughout the newspaper.

In reference to dependent claim 40, Huffman teaches:

The processor directly converts the text from the book into speech signals for the voice synthesizer. See column 8, lines 1-7.

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In reference to dependent claim 41, Huffman teaches:

Upon selecting the RF link option, an RF link routine is executed. The RF link routine allows the user to download updates of the text to the electronic book, and/or to interface the electronic book to a personal computer or communication unit. See column 12, lines 52-67.

In reference to dependent claim 42, 43, Huffman teaches:

Optionally, the machine-readable data is also representative of graphical information within the book. It is noted that the term book should be inclusive of books, magazines, newspapers, or the like. See column 5, lines 35-55.

In reference to claims 44-48, the limitations recite similar limitations to those claimed in numbers 40-43, and in further view of the following, are rejected under similar rationale.

Conclusion

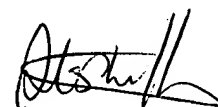
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J. Ludwig whose telephone number is 571-272-4127. The examiner can normally be reached on 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on 571-272-4124.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ML
December 21, 2004



STEPHEN HONG
SUPERVISORY PATENT EXAMINER